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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/939,896
Filing Date: August 27, 2001
Appellant(s): LEE ET AL.

Jonathan W. Hallman
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 23, 2008 appealing from the Office action mailed February 23, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

The amendment after final rejection filed on December 26, 2007 has been entered. This amendment removes the former 35 U.S.C. 112, 2nd paragraph rejection for lack of antecedent basis (final rejection dated February 23, 2007, p 3).

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is deficient. 37 C.F.R. §41.37(c)(1)(v) requires the summary of claimed subject matter to include: (1) a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number, and to the drawing, if any, by reference characters and (2) for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function as permitted by 35 U.S.C. §112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth

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with reference to the specification by page and line number, and to the drawing, if any, by reference characters. The brief is deficient because it does not contain a concise explanation of the subject matter.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2003/0046238

NONAKA ET AL.

3-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 36-40 are rejected under 35 U.S.C. §102(e) as being anticipated by Nonaka et al. (hereinafter Nonaka), US 2003/0046238 A1.

As per the following claims, Nonaka discloses:

36. A method of revoking a host device on a file-by-file basis, comprising:

- receiving at a storage engine a certificate from the host device, the certificate containing a digital signature (¶435,462-494);
- authenticating the digital signature (¶22-28, 54-66; figures 60, 61 and associated text);
- establishing a secure session by transmitting a session key to the host device (¶427-444); and during the secure session:
 - receiving at the storage engine a file request from the host device, the file request being directed to a file stored on a storage medium accessible to the storage engine (¶435, 671-675);
 - reading a revocation list associated with the file from the storage medium, the revocation list containing at least one rule, the at least one rule associating data in the revocation list with data in the certificate (¶435, 671-675);
 - applying the at least one rule on the data in the revocation list and the associated data in the certificate (¶247); and
 - if the application of the at least one rule provides a failing result, denying the file request (¶671-675; figures 60-61).

37. The method of claim 36, wherein the at least one rule comprises a plurality of rules (¶247, 857, 1085-1087).

38. The method of claim 36, wherein the storage medium is an optical disk (¶221).

39. The method of claim 36, wherein the application of the at least one rule act comprises matching the data in the revocation list with the data in the certificate (¶225,256, 283).

40. The method of claim 36, further comprising: if the application of the at least one rule provides a successful result, granting the file request (¶262-276; 359-370).

(10) Response to Argument

1) Rejection under 35 U.S.C. 112

The amendment after final rejection filed on December 26, 2007 has been entered. This amendment removes the former 35 U.S.C. §112, 2nd paragraph rejection for lack of antecedent basis (final rejection dated February 23, 2007, p 3).

2) Rejection under 35 U.S.C. 102(e)

Applicant argues: Applicant argues that "[a]ny revocation discussed in Nonanka would be with regard to the entire secure container and not to specific files within the secure container... Applicants readily agree with the Examiner that ¶435 of Nonanka discusses the inclusion of a revocation file within the SAM (secure application module); but that revocation list applies to the entire content of the SAM" (Appeal Brief May 23, 2008, p 8). Specifically, Applicant argues that Nonanka teaches "a classic 'all or nothing' revocation... In contrast, claim 36 provides a much more flexible and granular file-by-file revocation scheme" (Appeal Brief May 23, 2008, p 9). In summary, Applicant only argues that Nonanka teaches an "all or nothing" revocation, instead of Applicant's "file-by-file" basis.

Examiner's Response: Examiner respectfully disagrees. All the limitations of claims 36-40 are taught by Nonanka (please see rejection above and table below).

Claim	Applicant Claims	Nonaka Teaches
36	<ul style="list-style-type: none">• receiving at a storage engine a certificate from the host device, the certificate containing a digital signature• authenticating the digital signature• establishing a secure session by transmitting a session key to the host device; and during the secure session:• receiving at the storage engine a file request from the host device, the file request being directed to a file stored on a storage medium accessible to the storage engine	<ul style="list-style-type: none">• storage unit 192 has the following data... a public key certificate CER.sub.SAM1 in which the public key data K.sub.SAM1,P of the SAM 105.sub.1 is stored, signature data SIG.sub.22 of a public key certificate CER.sub.ESC (¶435, 462-494)• The public-key encryption circuit may verify the integrity of signature data (¶22-28, 54-66; figures 60, 61)• The encryption/decryption (decoding) unit 171 encrypts and decrypts the data sent to and received from the content provider 101 and the EMD service center 102 by using the session key K.sub.SES... the resulting MAC value is compared with the stored MAC value, thereby verifying the integrity of the key file KF... mutual authentication (establish a secure session) is performed between the mutual authentication unit 170 of the SAM 105.sub.1 and the EMD service center 102 (¶427-444)• Upon receiving the SAM registration list shown in FIG. 59 from the SAM 105.sub.1, the EMD service center 102 checks the effective period (¶435, 671-675)

<ul style="list-style-type: none">• reading a revocation list associated with the file from the storage medium, the revocation list containing at least one rule, the at least one rule associating data in the revocation list with data in the certificate• applying the at least one rule on the data in the revocation list and the associated data in the certificate• if the application of the at least one rule provides a failing result, denying the file request	<ul style="list-style-type: none">• Upon receiving the SAM registration list shown in FIG. 59 from the SAM 105.sub.1, the EMD service center 102 checks the effective period, and also checks for the settlement function designated by the SAM 105.sub.1 during registration. The EMD service center 102 refers to the prestored revocation list (certificate revocation list (CRL)) shown in FIG. 60 and sets the revocation flag within the SAM registration list... the EMD service center 102 checks the SAM registration list of the SAM 105.sub.1 for whether the SAMs described in the list are contained in the revocation list (¶435, 671-675)• The UCP data 106 is a descriptor which defines the operation rules of the content data C, for example, the suggested retailer's price (SRP) and the copying rules desired by the operator of the content provider 101 (¶247)• each SAM checks the revocation list for whether the corresponding SAM has become invalid, in which case, the communication therebetween is discontinued (denying the request) (¶671-675; figures 60-61)
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37	the at least one rule comprises a plurality of rules	The UCP data 106 is a descriptor which defines the operation rules of the content data C... the common rights processing rules can be employed in SAMs in the user home networks 303 and 303a based on the UCP data 106 created by the content provider 301 (§247, 857, 1085-1087)
38	the storage medium is an optical disk	a portable medium , for example, a semiconductor memory, such as, a Memory Stick (brand name), or an optical disc , such as, a mini disc (MD) (brand name) (§221)
39	the application of the at least one rule act comprises matching the data in the revocation list with the data in the certificate	determines based on the user digital watermark information module WM managed by the EMD service center 102 whether the content and the embedding position of the digital watermark information detected by the user home network 103 coincide with those managed by the EMD service center 102... the content provider 101 reads content data, i.e., a content master source, from the content master source database , and embeds digital watermark information in the content data (§225, 256, 283)
40	if the application of the at least one rule provides a successful result, granting	The secure RAM area 132 is an area which requires a predetermined permission

	<p>the file request</p>	<p>(authentication) to make access... The secure RAM area 132 also stores public key certificate revocation data for specifying the content provider 101 and the SAMs 105.sub.1 through 105.sub.4 which have become invalid... enables the SAMs 105.sub.1 through 105.sub.4 of the user home network 103 to perform rights processing based on the common UCP data 106... although the host CPU 810 receives the external interrupt S165 for purchasing or playing back the content (granting the file request), it request the SAM 105.sub.1 to execute the corresponding task. This is because the task involves the security, such as encryption processing, creating and checking signatures, accompanied by the processing for purchasing the key (application of the at least one rule) ($\text{¶}262\text{-}276$; 359-370)</p>
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The only issue posed by Applicant is whether Nonaka teaches a "file-by-file" revocation as claimed in claim 36 of the instant application.

First, Examiner notes that the language "file-by-file basis" only appears in the preamble of claim 36, not in the limitations themselves. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the

process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In the instant application, the preamble language "file-by-file basis" does not clarify the subsequent limitations; thus, the preamble language should not be given patentable weight when interpreting the claims.

Second, Applicant admits on the record that ¶435 of Nonanka discusses the inclusion of a revocation file within the SAM (Appeal Brief May 23, 2008, p 8). Furthermore, Nonanka teaches 1) that a secure container 104 stores a content file CF; 2) a SAM revocation list is formed for SAMs in the same system; and 3) said revocation list indicates whether each SAM is invalid (¶188-189, 196, 674). Given the broadest reasonable interpretation of the claims, a "file-by-file basis" may comprise rejecting files of the same system (e.g. rejecting SAMs connected to bus A versus bus B).

Third, Applicant fails to appreciate that a SAM may incorporate one file (¶188-189, 196, 674). Thus, rejecting one SAM (i.e. one file) would comprise a "file-by-file" revocation as claimed in claim 36.

Thus, Nonanka teaches file revocation on a file-by-file basis because 1) the preamble language "file-by-file basis" should not be given patentable weight; 2) a "file-by-file basis" may comprise rejecting files (i.e. SAMs) of the same system; and 3) a SAM may incorporate one file, so rejecting one SAM would comprise rejecting one file.

Examiner's note: Applicant argues against the conditional limitations warning that appeared in the final rejection dated February 23, 2007 (Appeal Brief May 23, 2008, p 9). This reminder appeared in the "Response to Arguments" section of the final rejection, and does not affect the 35 U.S.C. §102(e) rejection stated above. Moreover, the so called conditional limitations "warning" is not a warning at all but simply a statement of how the Examiner is interpreting the claim. Providing express notice of how an examiner interprets a claim is clearly not a new ground of rejection—let alone a "warning." It is instead, simply express notice of how the claim is interpreted. Finally, since Applicant is presumed to have actual knowledge of

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statutes, rules, and applicable caselaw, providing any caselaw in an office action is nothing more than a gentle reminder to Applicant of the state of the current law.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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